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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,256	10/31/2003	Kazuo Okada	SHO-0054	9221

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EXAMINER	
SHAH, MILAP	

ART UNIT	PAPER NUMBER
3712	

DATE MAILED: 09/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/697,256	OKADA, KAZUO	
	Examiner	Art Unit	
	Milap Shah	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 August 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *13-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *13-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 13-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 10/644,955. Although the conflicting claims are not identical, they recite similar subject matter.

In co-pending Application No. 10/644,955 it would have been obvious to one of ordinary skill in the art to merely change each of the language from "device" to "means" since they essentially have the same meaning. A "means" to carry out a task in a gaming machine must have a "device" for this task to be completed by, which can simply refer to a processor running a computer program. Thus, these claimed inventions are considered obvious variants of one another, such that given co-pending Application No. 10/644,955, the instant application could easily have been determined, or vise versa. Therefore, an obvious-type double patenting rejection is proper in the circumstances that statutory double patenting does not apply due to wording differences. It is submitted that the "meaning" or intent behind each of the claimed inventions of the instant application and Application No. 10/644,955 are equivalent.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

This rejection has been updated and/or modified to accommodate the canceled and amended claims. It is part of the rejection maintained from the previous action. See "Response to Arguments" section.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9 & 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated Nishikawa (JP Publication No. 2000-300729). The English translation of abstract, detailed description, and claims was provided with the previous action.

Claims 13 & 16: Nishikawa discloses the same structure for a gaming machine comprising variable display devices (gaming reels or drums), a lottery device for executing lottery of a winning combination (random number generator to generate a random gaming outcome), a stop control device, and a stop control selection device (i.e. a processor or gaming machine controller selectively stopping the reels at particular positions based on the determined game outcome as in almost any conventional gaming machine – see at least abstract, figures 3-5, and paragraphs 0002-009, 0013-0021 of English translation). Nishikawa also discloses a shielding control device being a liquid crystal display disposed in front of the variable display (figure 3) which changes between a state enabling a player to visually recognize some of the symbols and a state disabling the player from visually recognize some of the symbols (i.e. disable a player from viewing non-winning symbols via the liquid crystal display becoming opaque or colored in those positions, and enable a player to view the symbols associated with the winning pay line or winning combination so as to highlight the winning combination – see at least abstract, figures 3-5, and paragraphs 0002-0021 of English translation). Nishikawa's invention is quite capable of the following intended use. The "first shielding state" is considered the state in which a winning combination is displayed on the screen and thus, the control device, disables the viewing of non-winning symbols. The "second shielding state" is considered the state in which a non-winning combination is displayed on the screen and thus, the second shielding state is one in which no symbols are

disabled from view since no winning symbols are present to highlight. It is to be noted that claims 13 & 16 are apparatus claims in which functional language is not given weight for determining patentability. It is submitted that the structure of the instant claims and Nishikawa are equivalent, therefore, any specific intended use of the structural components are capable of being done by Nishikawa's gaming machine based on the equivalent structure. See MPEP 2114 directed to functional language in apparatus claims. An apparatus claim must be structurally distinguishable from the prior art.

Claim 14: As similarly discussed above, Nishikawa discloses the structure of the liquid crystal display capable of being an effect display, to display such arrangements as a bonus game, overtop the variable display after the second shielding state.

Claim 15: The liquid crystal display is considered an electronic shutter, as the display is a video display and "shutters" or blocks visibility of symbols.

Response to Arguments

Applicant's arguments filed August 29, 2006, do not appear to discuss the Examiners deduction on not meeting the priority requirements, as stated in the previous action. Therefore, it can only be assumed that the Applicant acquiesces in this issue and the Examiner will maintain the earliest filing date for this application is October 31, 2003.

Applicant's arguments with respect to the double patenting rejection of canceled claims 1-12 and currently pending claims 13-16 has been fully considered and is *partially* persuasive. The Examiner withdraws the rejection with respect to co-pending application 10/715,494 based upon amended and new claims 13-16 are the only claims remaining in the application. However, the rejection based on co-pending application 10/644,955 is maintained with respect to amended and

new claims 13-16. The Examiner provides why it would have been obvious and what was different about the claims. Thus, the Examiner maintains the obvious-type double patenting rejection and submits that a proper explanation was submitted and an updated explanation pertaining to claims 13-16 alone has been submitted.

Applicant's arguments with respect to claims 1-12 are moot in view of claims 1-12 being canceled. Consequently, any previous rejection pertaining to claims 1-12 are hereby withdrawn.

Applicant's arguments with respect to claims 13-16 have been considered but are moot in view of the new ground(s) of rejection. Nishikawa is used in the updated rejections above. Nishikawa, a foreign reference, was provided with an English translation in the previous action.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,817,946 to Motegi et al. disclose a similar invention in which a liquid crystal display is disposed in front of a variable display. Similar structure is disclosed, in which the LCD is capable of displaying images that disable a player from viewing symbols on the variable display.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on

the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, John Hotaling can be reached on (571) 272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.B.S.

Scott E. Jones

SCOTT JONES
PRIMARY EXAMINER